IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES

In re Application of:	Toni M. Piponius
Serial No.:	09/956,989
Filing Date:	September 21, 2001
Group Art Unit:	2155
Confirmation No.:	2944
Examiner:	David R. Lazaro
Title:	*Proxy for Content Service*

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

APPEAL BRIEF

Appellant has appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed August 21, 2007, finally rejecting Claims 1-11, 13-22, 24, 25, and 27-31, all of which are pending in this case. Appellant filed a Notice of Appeal on October 17, 2007.

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Real Party in Interest

This application is currently owned by Cisco Technology, Inc., as indicated by an assignment recorded on February 15, 2006, in the Assignment Records of the United States Patent and Trademark Office at Reel 017174, Frame 0380.

Related Appeals and Interferences

There are no known appeals or interferences, which will directly affect or be directly affected by or have a bearing on the Board's decision regarding this appeal.

Status of Claims

Claims 1-11, 13-22, 24, 25, and 27-31 are pending in this application. Claims 1-11, 13-22, 24, 25, and 27-31 are rejected pursuant to a Final Office Action mailed August 21, 2007, and are all presented for appeal. All pending claims are shown in Appendix A.

Status of Amendments

All amendments submitted by Appellant were entered by the Examiner before the issuance of the Final Office Action mailed August 21, 2007.

Summary of Claimed Subject Matter

Independent Claim 1 recites a method for providing a piece of content to a subscriber terminal from a content server (see FIGURES 1 and 2, where the subscriber terminal is represented as a mobile station [MS] and the content server is abbreviated as [CS]). The provision of the content from the content server to the subscriber terminal is controlled by a proxy, and said control of the content provision comprises the following steps:

- receiving, from the subscriber terminal, in the proxy a content request for providing the content,

- determining, by the proxy, whether or not the content is chargeable content, wherein the determining step includes accessing a database that includes information that is indicative of which content is chargeable and which content is free to end users connected to a network,

- determining by means of the proxy a billing address for the chargeable content,

- providing the content corresponding to the content request under the control of the proxy from the content server to the subscriber terminal, and

- generating billing information related to the chargeable content, wherein generating billing information includes accessing a subscriber terminal profile, and wherein the subscriber terminal profile includes a prepaid amount provided by an end user of the subscriber terminal. (See FIGURES 4-6, which represent functional flow diagrams for these operations. In addition, the Board is respectfully directed to paragraphs #35-#45, which discuss these operations in detail.]

Independent Claim 28 is analogous, as it recites similar [virtually identical] limitations.

Grounds of Rejection to be Reviewed on Appeal

Appellant requests that the Board review the Examiner's rejections of Claims 1, 6-8, 11, 13, 16, 19-22, 27 and 28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,047,051 issued to Ginzboorg et al. (hereinafter "*Ginzboorg*") in view of U.S. Patent No. 6,389,537 issued to Davis et al. (hereinafter "*Davis*").

Appellant requests that the Board review the Examiner's rejections of Claims 2-4 under 35 U.S.C. § 103(a) as being unpatentable over *Ginzboorg* in view of *Davis* and U.S. Patent No. 5,905,736 issued to Ronen et al. (hereinafter "*Ronen*").

Appellant requests that the Board review the Examiner's rejections of Claim 5 under 35 U.S.C. § 103(a) as being unpatentable over *Ginzboorg* in view of *Davis* and U.S. Patent No. 5,956,391 issued to Melen et al. (hereinafter "*Melen*").

Appellant requests that the Board review the Examiner's rejections of Claim 9 under 35 U.S.C. § 103(a) as being unpatentable over *Ginzboorg* in view of *Davis* and U.S. Patent No. 5,970,477 issued to Roden (hereinafter "*Roden*").

Appellant requests that the Board review the Examiner's rejections of Claims 10, 14, 15 under 35 U.S.C. § 103(a) as being unpatentable over *Ginzboorg* in view of *Davis* and U.S. Patent Publication No. 2002/0059114 issued to Cockrill et al. (hereinafter "*Cockrill*").

Appellant requests that the Board review the Examiner's rejections of Claim 17 under 35 U.S.C. § 103(a) as being unpatentable over *Ginzboorg* in view of *Davis* and U.S. Patent No. 5,852,812 issued to Reeder (hereinafter "*Reeder*").

Appellant requests that the Board review the Examiner's rejections of Claim 18 under 35 U.S.C. § 103(a) as being unpatentable over *Ginzboorg* in view of *Davis* and U.S. Patent No. 5,778,189 issued to Kimura et al. (hereinafter "*Kimura*").

Appellant requests that the Board review the Examiner's rejections of Claims 24 and 25 under 35 U.S.C. § 103(a) as being unpatentable over *Ginzboorg* in view of *Davis* and U.S. Patent No. 5,319,454 issued to Schutte (hereinafter "*Schutte*").

Appellant requests that the Board review the Examiner's rejections of Claims 29-31 under 35 U.S.C. 103 (a) as being unpatentable over *Ginzboorg* in view of *Ronen*.

Argument

I.   Independent Claim 1 is Patentable over the *Ginzboorg/Davis/Cockrill* Combination.

Ginzboorg is problematic for a number of tangible reasons.   For example, Independent Claim 1 recites an architecture in which the provision of the content from the content server to the subscriber terminal is controlled by a proxy. The proxy controls the information flow from the Content Server to the subscriber terminal. Nothing in *Ginzboorg* accounts for this control and this control is circumscribed by Independent Claim 1. *Ginzboorg*, instead, offers a billing server that *authenticates or authorizes content*: not control its delivery.

A fundamental difference between *Ginzboorg* and the pending subject matter is that a request for content is received by the proxy before content is retrieved from a content server. This is disparate from the teachings of *Ginzboorg*. This order of operation is critical for billing by the proxy.

Indeed, at the very passage cited by the Examiner for supporting the §103 rejection, *Ginzboorg* discloses: "The customer terminal CT, includes a service browser (which can be, for example, a Web browser), which the customer uses to find suitable services from the Internet.   After finding a suitable service, which in this example is the Video-on-Demand service of service provider SP1, the customer selects the service in question (for example, a movie) by clicking the option, for example. The service selection stage is indicated by arrow A.   So, at this point, the customer terminal and the server of the service provider communicate.

When the customer has made the selection, the server of the service provider sends to the billing server WD, (arrow B) the service identifier "Sid," identifying the movie in question, and the subscriber identifier "Cid" of the customer in question.   The Cid is obtained, for example, from the customer's browser on the basis of the source address of the received messages (for example, the socket address of the TCP connection). So the browser is always required to provide the customer identity and address, at least to the billing service

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provider, but preferably also to the service provider." (See *Ginzboorg* at Column 5: lines 43-62.)

The timing of these billing operations is important for several reasons. First, the proxy of the present invention is able to determine how to bill this content before it is provided. This is not akin to the operations of *Ginzboorg*. Second, in more specific applications, this proxy configuration would allow the proxy to prohibit the delivery of certain content due to an outstanding balance of the subscriber terminal. Third, the architecture of the present invention avoids the communication of *Ginzboorg* (from a content provider to a proxy), as the restriction (or decision making) is placed on the "front end" of the request in the present invention. This would eliminate additional processing by the content server, which would (in theory) always be required to ascribe an identity for an end user requesting the information being delivered and then to send that to the proxy to be stored and processed. Using the architecture outlined by the pending claims, the content server would not have to be modified to provide this extra communication because the proxy is configured to make content routing decisions. For at least this reason, Independent Claim 1 is patentable over *Ginzboorg*.

Just as importantly, *Ginzboorg* fails to discern between *chargeable* and *free content*, as its disclosure reads. Applicant has reviewed the portions of *Ginzboorg* cited for this limitation, but has yet to discover any portion of *Ginzboorg* that would be germane to such a teaching. Note that it is the proxy of Independent Claim 1 that is tasked with this determination: not some other random element within the system.

In particular, the ability of the proxy to make this determination is significant for a number of reasons. For example, if the proxy performs such an analysis, then the content provider itself is no longer taxed by the organizational chore of recognizing which content is to be charged for. This would allow a given server to simply provide the content freely, while the proxy would operate as a regulator in this scenario. Note that this determination is not being executed by any other component; the decision is being made at the same node that generates billing information, namely the proxy. Traffic, whether chargeable or not, flows through the proxy. In a general sense, the proxy is used to keep track of the burdensome data and, thereby, allows the content provider to more efficiently perform its designated

assignments: particularly, to deliver content to those subscriber terminals requesting such content. Accordingly, Independent Claim 1 is patentable over *Ginzboorg* and over the proposed *Ginzboorg-Davis* combination for at least these additional reasons.

There are still other reasons why Independent Claim 1 is patentable over the proposed §103 rejection. Independent Claim 1 discloses the use of <u>a prepaid amount for the subscriber terminal</u>, which is not taught by *Ginzboorg*. The Examiner relies on *Davis* for this limitation and explains that such a protocol is 'simple' and 'common' in content provisioning. Applicant respectfully disagrees, as such a feature is unique: particularly so when considered at the time this case was filed.

Another fundamental difference between *Ginzboorg* and the pending subject matter that the Examiner should appreciate is that *Ginzboorg* pertains to a service and not to content delivery. Referencing again the passage of *Ginzboorg* provided supra, it is evident that *Ginzboorg* deals with types of service (e.g. Video-On-Demand) and not specific content. Evaluating *Ginzboorg* thoroughly confirms that its architecture is confined to services being provided to the subscriber terminal. Although this distinction appears to be minor, it is truly significant.

For example, in the context of *Ginzboorg*, this would correlate to a subscriber terminal being billed for a given movie (e.g. Braveheart), as opposed to the service of Video-On-Demand. *Ginzboorg* clearly does not provide for such content billing. In contrast, the architecture circumscribed by Independent Claim 1 relates to the actual content being delivered to the subscriber terminal (e.g. web pages, on-line newspapers, etc.), and not a service (e.g. enhanced QoS features, Video-On-Demand, etc.). For at least this additional reason, Independent Claim 1 is patentable over the *Ginzboorg* combination and, furthermore, over any of the other references of record.

For at least these reasons outlined above, Independent Claim 1 is clearly allowable over the proposed combinations. In addition, Independent Claim 29 includes a limitation that is similar, but not identical, to that of Independent Claim 1. Accordingly, this Independent Claim is also allowable over the proffered combinations using a similar rationale. Additionally, the dependent claims corresponding of these Independent Claims are also allowable for analogous reasons.

In addition, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed below, the claimed invention taken as a whole still cannot be said to be obvious without some reason why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The controlling case law, rules, and guidelines repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142.

The U.S. Supreme Court's recent decision in *KSR Int'l Co. v. Teleflex, Inc.* reiterated the requirement that Examiners provide an explanation as to why the claimed invention would have been obvious. *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727 (2007). The analysis regarding an apparent reason to combine the known elements in the fashion claimed in the patent at issue "should be made explicit." *KSR*, 127 S.Ct. at 1740-41. "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* at 1741 (internal quotations omitted).

The new examination guidelines issued by the United States Patent and Trademark Office ("PTO") in response to the *KSR* decision further emphasize the importance of an explicit, articulated reason why the claimed invention is obvious. Those guidelines state, in part, that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." *Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.*, 72 Fed. Reg. 57526, 57528-29 (Oct. 10, 2007) (internal citations omitted). The guidelines further describe a number of rationales that, in the PTO's view, can support a finding of obviousness. *Id.* at 57529-34. The guidelines set forth a number of particular findings of fact that must be made

and explained by the Examiner to support a finding of obviousness based on one of those rationales. *See id.*

Thus, all of the pending claims have been shown to be allowable, as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these pending claims.

Conclusion

Appellant has demonstrated that the present invention, as claimed, is clearly distinguishable over the prior art cited by the Examiner. Therefore, Appellant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

The Commissioner is hereby authorized to charge the statutory fee of $510.00 for the filing of the Appeal Brief to Deposit Account No. 02-0384. In addition, the Commissioner is hereby authorized to charge any deficiencies and credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,
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Date: December 17, 2007

Customer No. **05073**

DAL01:988840.1

Appendix A: Claims on Appeal

1.   (Previously Presented)   A method for providing a piece of content to a subscriber terminal from a content server, wherein the provision of the content from the content server to the subscriber terminal is controlled by a proxy, and said control of the content provision comprises the following steps:

- receiving, from the subscriber terminal, in the proxy a content request for providing the content,

- determining, by the proxy, whether or not the content is chargeable content, wherein the determining step includes accessing a database that includes information that is indicative of which content is chargeable and which content is free to end users connected to a network,

- determining by means of the proxy a billing address for the chargeable content,

- providing the content corresponding to the content request under the control of the proxy from the content server to the subscriber terminal, and

- generating billing information related to the chargeable content, wherein generating billing information includes accessing a subscriber terminal profile, and wherein the subscriber terminal profile includes a prepaid amount provided by an end user of the subscriber terminal.

2.   (Original) A method as claimed in claim 1, wherein the subscriber terminal is located in an access network in which the subscriber terminal is addressed by an access network subscriber identity, and the content server is located in a service network in which it is addressed by an IP address, and wherein the determination of the billing address comprises the following steps:

- allocating an IP address to the subscriber identity in the access network or at its edge,

- receiving in the proxy the IP address allocated to the subscriber identity,

- determining in the proxy on the basis of the received IP address the subscriber identity of the subscriber terminal and using it to determine the billing address.

3.   (Previously Presented) A method as claimed in Claim 2, wherein the determination of the subscriber identity on the basis of the received IP address comprises an inquiry to a database in the proxy.

4.   (Previously Presented) A method as claimed in Claim 2, wherein the determination of the subscriber identity on the basis of the received IP address comprises an inquiry to the access network.

5.   (Previously Presented) A method as claimed in claim 1, wherein said billing information related to the content is sent to the access network to be combined with billing information of the access network.

6.   (Original) A method as claimed in claim 1, wherein the subscriber identity of the subscriber terminal is hidden from the content server.

7.   (Previously Presented) A method as claimed in claim 1, wherein the generation of the billing information related to the content comprises the step of maintaining billing criteria in a database functionally connected to the proxy.

8.   (Previously Presented) A method as claimed in claim 1, wherein the billing criteria comprise the payer of the content.

9.   (Previously Presented) A method as claimed in claim 1, wherein if a content provider pays for the content, the content provider pays for telecommunications costs between the subscriber terminal and the proxy, in which case the use of the content is completely free of charge to the subscriber.

10.   (Previously Presented) A method as claimed in claim 1, wherein the billing criteria comprise information on whether the subscriber in question has already been billed for the same content, in which case the following uses of the same content will be billed according to a lower tariff or not at all.

11.   (Previously Presented) A method as claimed in claim 1, wherein the billing criteria comprise information on whether the content in question belongs to a group of content segments with a special price.

12.   (Canceled)

13.   (Previously Presented) The method of Claim 1, wherein determining the billing address comprises:
        allocating an IP address to the subscriber terminal in an access network;
        receiving, in the proxy, the IP address allocated to the subscriber terminal; and
        determining, in the proxy, a subscriber identity based on the IP address and correlating it to the billing address.

14.   (Previously Presented) The method of Claim 1, wherein the billing information is generated based on billing criteria that includes whether or not the subscriber terminal has previously been billed for the same content.

15.   (Previously Presented)   The method of Claim 1, wherein the billing information is generated based on billing criteria that includes whether or not the content is part of a group of content segments that are offered at a special price.

16.   (Previously Presented) The method of Claim 1, wherein if the content is part of a group of content segments, then the subscriber terminal is entitled to use a portion of the group at a lower price or for free.

17.   (Previously Presented) The method Claim 1, further comprising:

performing, by the proxy, one or more currency conversions in cases where currencies used in an access network, to which the subscriber terminal is part of, and a service network, which can couple the proxy and the content server, are different.

18.   (Previously Presented) The method of Claim 1, further comprising:

performing, by the proxy, one or more protocol conversions in cases where protocols used in an access network, to which the subscriber terminal is part of, and a service network, which can couple the proxy and the content server, are different.

19.   (Previously Presented) The method of Claim 1, wherein generating billing information further includes billing the subscriber terminal for content delivered by the content server to the subscriber terminal.

20.   (Previously Presented)   The method of Claim 1, wherein the proxy is configured to identify one or more pieces of content that are included in an agreement between an operator of the content server and an operator of the proxy.

21.   (Previously Presented) The method of Claim 1, wherein the proxy does not forward the content request to the content server until the proxy identifies whether or not selected content is included in an agreement between an operator of the content server and an operator of the proxy.

22.   (Previously Presented) The method of Claim 1, wherein the proxy directly forwards the content request to the content server after the proxy identifies that selected content is not included in an agreement between an operator of the content server and an operator of the proxy.

23.   (Canceled)

24.   (Previously Presented) The method of Claim 1, wherein the subscriber terminal profile includes a maximum amount for unbilled content that is reflected by an agreement between an end user of the subscriber terminal and an operator of the content server or an operator of the proxy.

25.   (Previously Presented) The method of Claim 1, wherein the proxy does not fulfill the content request if the maximum amount for unbilled content has been reached.

26.   (Canceled)

27.   (Previously Presented) The method of Claim 1, wherein the content is not billed at one time because it corresponds to streaming content.

28.   (Previously Presented) The method of Claim 1, wherein a price for the content is determined based on a time at which the content is requested.

29.   (Previously Presented)   A proxy system for providing content service, the apparatus comprising:

a router component in communication with a subscriber terminal through an access network, the router component operable to receive a request for content service from the subscriber terminal and to determine if the content service is chargeable, the content being provided by a content server;

a web switch component operable to receive the request from the router component and to deliver the content service to the subscriber terminal if the content service is chargeable; and

a processor component comprising control logic operable to determine a billing address for the subscriber terminal based on a subscriber identity that uniquely identifies the subscriber terminal to the access network, to monitor the delivery of the content service to the subscriber terminal, and to generate billing information based on the delivery of the content service.

30.   (Previously Presented) The proxy system of Claim 29, wherein the processor component further comprises control logic operable to transmit the billing information to a billing system associated with the access network.

31.   (Previously Presented) The proxy system of Claim 30, wherein the processor component determines the billing address by matching the subscriber identity to a network address received from the subscriber terminal.

Appendix B: Evidence

NONE

Appendix C: Related Proceedings

NONE